



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/740,928 | 12/21/2000 | David Henry Solomon | 47-142 | 7638 |

7590 01/06/2004
Nixon & Vanderhye P.C.
8th Floor
1100 N. Glebe Rd.
Arlington, VA 22201

EXAMINER

CAIN, EDWARD J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1714

DATE MAILED: 01/06/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,928

Applicant(s)

SOLOMON ET AL.

Examiner

Edward J. Cain

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/214,716.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Art Unit: 1714

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by GB '609.

GB '609 discloses compounds meeting the limitations of applicants formula of claim 12 (see page 1).

Claim 13 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Muller et al.

Muller et al disclose carboxamido (meth) acrylic acid esters encompassed by applicants formula of the rejected claim (see abstract).

Claims 15-17 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Cain whose telephone number is (571) 272-1118. The examiner can normally be reached on M-F from 10:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 703 306-2777. The fax phone


Art Unit: 1714

number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

EDWARD J. CAIN
PRIMARY EXAMINER
GROUP 1500



| | | | |
|--|-----------------|-----------------|--|
| Application Number  | Application No. | Applicant(s) | |
| | 09/740,928 | SOLOMON, ET AL. | |
| | Examiner | Art Unit | |
| | Edward J. Cain | 1714 | |

Index of Claims



Application No.

09/740,928

Examiner

Edward J. Cain

Applicant(s)

SOLOMON ET AL.

Art Unit

1714

| | |
|---|----------|
| √ | Rej cted |
| = | Allowed |

| | |
|---|--------------------------------|
| — | (Through numeral) Cancelled |
| ÷ | Restricted |

| | |
|---|--------------|
| N | Non-Elected |
| I | Interference |

| | |
|---|----------|
| A | Appeal |
| O | Objected |

| Claim | | Date | | | | | | | | | | | |
|-------|----------|------|--|--|--|--|--|--|--|--|--|--|--|
| Final | Original | | | | | | | | | | | | |
| | 1 | | | | | | | | | | | | |
| | 2 | | | | | | | | | | | | |
| | 3 | | | | | | | | | | | | |
| | 4 | | | | | | | | | | | | |
| | 5 | | | | | | | | | | | | |
| | 6 | | | | | | | | | | | | |
| | 7 | | | | | | | | | | | | |
| | 8 | | | | | | | | | | | | |
| | 9 | | | | | | | | | | | | |
| | 10 | | | | | | | | | | | | |
| | 11 | | | | | | | | | | | | |
| | 12 | √ | | | | | | | | | | | |
| | 13 | √ | | | | | | | | | | | |
| | 14 | | | | | | | | | | | | |
| | 15 | = | | | | | | | | | | | |
| | 16 | = | | | | | | | | | | | |
| | 17 | = | | | | | | | | | | | |
| | 18 | | | | | | | | | | | | |
| | 19 | | | | | | | | | | | | |
| | 20 | | | | | | | | | | | | |
| | 21 | | | | | | | | | | | | |
| | 22 | | | | | | | | | | | | |
| | 23 | | | | | | | | | | | | |
| | 24 | | | | | | | | | | | | |
| | 25 | | | | | | | | | | | | |
| | 26 | | | | | | | | | | | | |
| | 27 | | | | | | | | | | | | |
| | 28 | | | | | | | | | | | | |
| | 29 | | | | | | | | | | | | |
| | 30 | | | | | | | | | | | | |
| | 31 | | | | | | | | | | | | |
| | 32 | | | | | | | | | | | | |
| | 33 | | | | | | | | | | | | |
| | 34 | | | | | | | | | | | | |
| | 35 | | | | | | | | | | | | |
| | 36 | | | | | | | | | | | | |
| | 37 | | | | | | | | | | | | |
| | 38 | | | | | | | | | | | | |
| | 39 | | | | | | | | | | | | |
| | 40 | | | | | | | | | | | | |
| | 41 | | | | | | | | | | | | |
| | 42 | | | | | | | | | | | | |
| | 43 | | | | | | | | | | | | |
| | 44 | | | | | | | | | | | | |
| | 45 | | | | | | | | | | | | |
| | 46 | | | | | | | | | | | | |
| | 47 | | | | | | | | | | | | |
| | 48 | | | | | | | | | | | | |
| | 49 | | | | | | | | | | | | |
| | 50 | | | | | | | | | | | | |

| Claim | | Date | | | | | | | | | | | |
|-------|----------|------|--|--|--|--|--|--|--|--|--|--|--|
| Final | Original | | | | | | | | | | | | |
| | 51 | | | | | | | | | | | | |
| | 52 | | | | | | | | | | | | |
| | 53 | | | | | | | | | | | | |
| | 54 | | | | | | | | | | | | |
| | 55 | | | | | | | | | | | | |
| | 56 | | | | | | | | | | | | |
| | 57 | | | | | | | | | | | | |
| | 58 | | | | | | | | | | | | |
| | 59 | | | | | | | | | | | | |
| | 60 | | | | | | | | | | | | |
| | 61 | | | | | | | | | | | | |
| | 62 | | | | | | | | | | | | |
| | 63 | | | | | | | | | | | | |
| | 64 | | | | | | | | | | | | |
| | 65 | | | | | | | | | | | | |
| | 66 | | | | | | | | | | | | |
| | 67 | | | | | | | | | | | | |
| | 68 | | | | | | | | | | | | |
| | 69 | | | | | | | | | | | | |
| | 70 | | | | | | | | | | | | |
| | 71 | | | | | | | | | | | | |
| | 72 | | | | | | | | | | | | |
| | 73 | | | | | | | | | | | | |
| | 74 | | | | | | | | | | | | |
| | 75 | | | | | | | | | | | | |
| | 76 | | | | | | | | | | | | |
| | 77 | | | | | | | | | | | | |
| | 78 | | | | | | | | | | | | |
| | 79 | | | | | | | | | | | | |
| | 80 | | | | | | | | | | | | |
| | 81 | | | | | | | | | | | | |
| | 82 | | | | | | | | | | | | |
| | 83 | | | | | | | | | | | | |
| | 84 | | | | | | | | | | | | |
| | 85 | | | | | | | | | | | | |
| | 86 | | | | | | | | | | | | |
| | 87 | | | | | | | | | | | | |
| | 88 | | | | | | | | | | | | |
| | 89 | | | | | | | | | | | | |
| | 90 | | | | | | | | | | | | |
| | 91 | | | | | | | | | | | | |
| | 92 | | | | | | | | | | | | |
| | 93 | | | | | | | | | | | | |
| | 94 | | | | | | | | | | | | |
| | 95 | | | | | | | | | | | | |
| | 96 | | | | | | | | | | | | |
| | 97 | | | | | | | | | | | | |
| | 98 | | | | | | | | | | | | |
| | 99 | | | | | | | | | | | | |
| | 100 | | | | | | | | | | | | |

| Claim | | Date | | | | | | | | | | | |
|-------|----------|------|--|--|--|--|--|--|--|--|--|--|--|
| Final | Original | | | | | | | | | | | | |
| | 101 | | | | | | | | | | | | |
| | 102 | | | | | | | | | | | | |
| | 103 | | | | | | | | | | | | |
| | 104 | | | | | | | | | | | | |
| | 105 | | | | | | | | | | | | |
| | 106 | | | | | | | | | | | | |
| | 107 | | | | | | | | | | | | |
| | 108 | | | | | | | | | | | | |
| | 109 | | | | | | | | | | | | |
| | 110 | | | | | | | | | | | | |
| | 111 | | | | | | | | | | | | |
| | 112 | | | | | | | | | | | | |
| | 113 | | | | | | | | | | | | |
| | 114 | | | | | | | | | | | | |
| | 115 | | | | | | | | | | | | |
| | 116 | | | | | | | | | | | | |
| | 117 | | | | | | | | | | | | |
| | 118 | | | | | | | | | | | | |
| | 119 | | | | | | | | | | | | |
| | 120 | | | | | | | | | | | | |
| | 121 | | | | | | | | | | | | |
| | 122 | | | | | | | | | | | | |
| | 123 | | | | | | | | | | | | |
| | 124 | | | | | | | | | | | | |
| | 125 | | | | | | | | | | | | |
| | 126 | | | | | | | | | | | | |
| | 127 | | | | | | | | | | | | |
| | 128 | | | | | | | | | | | | |
| | 129 | | | | | | | | | | | | |
| | 130 | | | | | | | | | | | | |
| | 131 | | | | | | | | | | | | |
| | 132 | | | | | | | | | | | | |
| | 133 | | | | | | | | | | | | |
| | 134 | | | | | | | | | | | | |
| | 135 | | | | | | | | | | | | |
| | 136 | | | | | | | | | | | | |
| | 137 | | | | | | | | | | | | |
| | 138 | | | | | | | | | | | | |
| | 139 | | | | | | | | | | | | |
| | 140 | | | | | | | | | | | | |
| | 141 | | | | | | | | | | | | |
| | 142 | | | | | | | | | | | | |
| | 143 | | | | | | | | | | | | |
| | 144 | | | | | | | | | | | | |
| | 145 | | | | | | | | | | | | |
| | 146 | | | | | | | | | | | | |
| | 147 | | | | | | | | | | | | |
| | 148 | | | | | | | | | | | | |
| | 149 | | | | | | | | | | | | |
| | 150 | | | | | | | | | | | | |

Search Notes

Application No.

09/740,928

Examiner

Edward J. Cain

Applicant(s)

SOLOMON ET AL.

Art Unit

1714

SEARCHED

| Class | Subclass | Date | Examiner |
|-------|----------|------|----------|
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |
| | | | |

INTERFERENCE SEARCHED

| Class | Subclass | Date | Examiner |
|-------|----------|------|----------|
| | | | |
| | | | |
| | | | |
| | | | |

**SEARCH NOTES
(INCLUDING SEARCH STRATEGY)**

| | DATE | EXMR |
|----------------------------|------------|------|
| Stic search. See print out | 11/21/2003 | EC |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |